

REMARKS

Reexamination and reconsideration of the rejections are hereby requested.

Claims 40-62 are pending in this application and stand rejected under 35 USC § 102(g) over the sole lost count of patent interference number 105, 406. In making her rejection, the examiner asserts that the subject matter of pending claims 40-62 is generic to the subject matter of the lost count and refers to example 2 in MPEP § 2308.03 asserting that the generic claim encompasses subject matter lost in the interference.

The lost count recites:

143. A method of forming a film of crystalline $\text{YBa}_2\text{Cu}_3\text{O}_7$ comprising:

forming a precursor film comprising barium (Ba), fluorine (F), yttrium (Y) and copper (Cu);

heat-treating said precursor film at a temperature above about 700° C in the presence of oxygen and water vapor at a sub-atmospheric pressure to form a crystalline structure; and

annealing said crystalline structure in the presence of oxygen.

The single independent claim in this case, Claim 40, recites:

A method of producing an oriented oxide superconducting film, comprising:

(a) providing a metal oxyfluoride film on a substrate, said metal oxyfluoride film comprising the constituent metallic elements of an oxide superconductor in substantially stoichiometric proportions;

(b) converting the metal oxyfluoride into the oxide superconductor in a processing gas having a total pressure less than atmospheric pressure under conditions that enable the removal of HF from the film surface.

If the examiner is correct that pending Claim 40 is generic to the subject matter of the lost count set forth above, it then follows that independent Claim 40 would read on the subject matter of the lost count. That is, pending independent Claim 40 would prevent the unlicensed practice of the subject matter of the lost count.

There are at least five limitations in pending Claim 40 that are not part of the subject matter of the lost count. First of all, pending Claim 40 is directed to a method of producing an

oriented oxide superconducting film. The subject matter of the lost count is not directed to producing an *oriented* oxide superconducting film. Second, pending Claim 40 recites “providing a metal *oxyfluoride* film on a substrate”. In contrast, the subject matter of the lost count merely recites forming a pre-cursor film comprising barium, fluorine, yttrium and copper. There is no recitation of oxygen that would be necessary for an oxyfluoride film. Third, pending Claim 40 recites that the oxyfluoride film includes the constituent metallic elements of an oxide superconductor in substantially stoichiometric proportions. The subject matter of the lost count does not include the requirement that the barium, fluorine, yttrium and copper be in substantially stoichiometric proportions of a resulting oxide superconductor. Fourth, independent Claim 40 requires converting the metal oxyfluoride into the oxide superconductor. Since the subject matter of the lost count does not include forming a precursor oxyfluoride film on a substrate, it cannot encompass converting a metal oxyfluoride into the oxide superconductor. Fifth, and finally, independent Claim 40 recites converting the metal oxyfluoride into the oxide superconductor under conditions that enable the removal of hf from the film surface. The subject matter of the lost count does not include processing under conditions that enable the removal of HF from the film surface.

Therefore, it is submitted that it is quite clear that independent pending Claim 40 cannot be considered generic to the subject matter of the lost count because Claim 40, in at least the five respects set out above, does not read on the subject matter of the lost count. In fact, it is more nearly the case that the subject matter of the lost count is generic to pending independent Claim 40 in that many limitations of the lost count are broader than limitations in Claim 40. For example, the subject matter of the lost count recites a precursor film having the metallic components of the superconductor but does not require providing an oxyfluoride film.¹

It is submitted that Claim 40 does not read on, and is therefore not generic to, the subject matter of the lost count as discussed above. Further, it is submitted that independent pending Claim 40 is not obvious in view of the subject matter of the lost count since the lost count does not require the metallic elements to be in substantially stoichiometric proportions and does not teach processing under conditions that enable removal of HF.

¹ Strictly speaking, neither the subject matter of the lost count nor pending Claim 40 are in a genus-species relationship because the lost count includes a temperature limitation that is not part of pending Claim 40.

For the foregoing reasons, it is submitted that pending Claims 40-62 are not anticipated by, nor rendered obvious over, the subject matter of the lost count in the interference. Early favorable action is requested.

Respectfully submitted,

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